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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,465	01/04/2001	William J. Gray	10655.9900	3628

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,465

Applicant(s)

GRAY ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1, 3-5, 39 and 40 have been examined.

Response to Amendments/Arguments

2. Examiner maintains the 112 rejection as the Applicant has not pointed out evidence in the Specification of a smart card that transmits signature data to a wallet server. On the other hand, Applicant describes a computer with a browser interface (figures 1 and 2; page 7, lines 24-31; page 9, lines 11-21; page 10, lines 20-27) for communicating with a wallet server. Further, Microsoft Press Computer Dictionary Third Edition defines a "smart card" as a circuit board with built in logic or firmware that gives the computer, electronic device, or circuit some kind of decision making ability. According to this definition, and in light of the silence of Applicant's Specification regarding the transmission of signature data by a smart card, the computer of Linehan et al. is or at least comprises a "smart card" (note Applicant's claims are silent regarding characteristics or terms such as IC card, ISO-7816, magnetic stripe or smart card reader). For clarification of the term "transaction instrument" Applicant makes references to the Specification, however it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not

read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). Therefore, Examiner's interpretation of Applicant's "transaction instrument", and smart card, are valid.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 5 is directed to a wallet server receiving a request that includes transaction data from a smart card. However, the Specification merely recites a user using a smart card to authenticate a transaction. The smart card of the Applicant's system does not send transaction data (Specification, page 10, lines 1-5 and 10-31; page 11, lines 10-32) (Note, it is the computer that sends the data not the smart card).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linehan, U.S. Patent No. 6,327, 578.

As per claims 1-5, 39 and 40, Linehan teaches a method for facilitating a transaction comprising:

- receiving a request at a wallet server, from a user for payment authorization, said authorization directed to a financial institution receiving (column/line 5/61-6/4)
- receiving signature data, by a wallet server, from a transaction instrument (e.g. merchant computer) wherein said transaction instrument includes signature data configured to authenticate that said transaction instrument was physically interfaced with said wallet server, wherein the authenticating is performed by obtaining

verification of authenticity of said signature from a security server
(column 6, lines 8-13)

- wallet server receiving authorization of said request (column 6, lines 1-35)
- wallet server associating authentication data with at least one “form” (column 6, lines 36-43) and providing said form to a merchant server to facilitate merchant using said form to obtain authorization from a security server (column 6, lines 36-43 and 47-62)
- wherein said request includes purchase information, charge information and transaction identifying information (column/line 5/57-6/15)
- authorizing transaction data by said wallet server to obtain authentication (e.g. authentication token, reference number) from a security server (column 6, lines 20-32)
- receiving a request at a wallet server and at a digital wallet (column/line 2/65-3/3) (e.g. payment request) (column/line 5/50-6/3)
- wherein the transaction instrument (e.g. merchant computer) is a computer or electronic device with a circuit board with built in logic or firmware that gives the computer, electronic device, or circuit
-

some kind of decision making ability (i.e. smart card) (column 5, lines 50-58)

Regarding a coincidence between the security server from which the wallet server receives authentication data and the security server that receives a "form" from a merchant. Linehan teaches a security server such as a bank (figure 2A, items 208 and 212), therefore, if in the Linehan model, the merchant and the user share the same bank or financial institution, the last limitation of claim 1 is satisfied.

Regarding "forms", in order to settle a dispute a merchant can produce a copy of the token that contains data such as payment amount, order description, time stamp, a random nonce, merchant ID, and customer account reference number. Further, the token is completed, and transmitted to a merchant by the wallet server and the merchant server, in turn, transmits the token to a security server (column 6, lines 20-37). Hence, the token of Linehan satisfies the conditions of a "form" according to Applicant's Disclosure (Specification, page 10, lines 17-28).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

Art Unit: 3621

(703) 872-9306 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Calvin Loyd Hewitt II

June 27, 2005

Sumner Back
Primary Examiner
3621